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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,027	10/17/2001	Guenaelle Martin	214862US0	3816
22850	7590	06/17/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,027

Applicant(s)

MARTIN ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 23, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of Amendment filed on February 23, 2004. Claims 1-18 are pending. Claim rejection made under 35 U.S.C. § 102 as indicated in the previous Office action dated November 21, 2003 is withdrawn and modified to address the newly added claims. Claim rejection made under 35 U.S.C § 103 as indicated in the same Office action is also withdrawn and modified to address the new claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 17 and 18 claim a composition and a method of using a composition excluding histidine. It is well settled in patent law that any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP § 2173.05(h). If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See Ex parte Grasselli, 231 USPQ 393

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(Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. In this case, histidine is not described in the applicants' original disclosure, and there is no basis for the negative limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

Claims 1-3, 5, 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Boussouira (EP 2779060).

Boussouira teaches a cosmetic composition comprising retinol and histidine. See abstract; English equivalent (US 6358514 B1). The reference teaches that it is well known in the art to add sunscreen agent "to reinforce the stability" of the retinoid-polyamino polymer combination by "limiting the harmful action of UV on the retinoid". The reference teaches using camphor derivatives among other sunscreens, and particularly mentions benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid). See Boussouira, p. 8, line 35 – p. 9, line 19; '514 patent, p. 7, line 52 – col. 8, line 13. The reference teaches using 0.0001 – 10 % by weight of retinoid. See Boussouira, p. 9, line 38 – p. 10, line 3; '514 patent, col. 8, lines 36 – 43. The reference also teaches o/w emulsion form of the invention. See Boussouira, Example 2. The reference teaches the claimed method of treating and preventing photoinduced aging skin by applying a

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composition comprising retinoid. See Boussouira, p. 1, lines 2 – 35; '514 patent, col. 1, lines 17 – 44.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding (US 5705144) in view of Forestier et al. (US 5302376) ("Forestier").

Harding teaches a cosmetic composition comprising retinoid and a dioc acid. See abstract. The reference teaches "co-formulation with a sunscreen enhances the photo-stability and activity of retinal or its derivative within the formulation and also prevent further actinic damage to all epidermal cells". See col. 2, lines 51 – 62. The reference teaches using 0.5 – 5 % by weight of the retinoid. See col. 3, lines 10 – 14; instant claim 3. See col. 6, line 45 – col. 8, line 11 for useful sunscreens including Benzophenone –3, octyl salicylate, octyl methoxy-cinnamate. See instant claims 6-10.

Harding fails to teach benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid).

Forestier teaches a cosmetic emulsion comprising benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) as the active UV screening agent. See abstract. The reference teaches using 0.1-10 % of the UV screening agent by weight of the emulsion. See col. 3, line 61 – col. 4, line 5; instant claim 4. The reference teaches o/w emulsion. See col. 4, lines 6 – 10; instant claim 5. The reference teaches that the screening agent provides sufficient screening for sensitive skin, and produces high sun-

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protection at low concentration. See col. 2, lines 2, and lines 1 – 24. The reference also teaches that the composition is advantageous in that it is thermally and photochemically stable, not toxic and harmless to the skin. See col. 2, lines 64 – 68. Examiner views that the recited stability of retinoid is a resulting physical property of the obvious variation of the prior arts. Neither Harding or Forestier teaches using histidine in the compositions. See instant claims 17 and 18.

Given the general teaching of stabilizing retinoid by adding sunscreen agent in Harding, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior art such as Forestier for specific sun screening agent. The skilled artisan would have been modified the composition of Harding by adding benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) as motivated by Forestier because of an expectation of successfully producing a stable retinoid composition. The motivation to add the specific sun screening agent is found in the teachings of the Boussouira reference and particularly in Forestier reference which teaches that the camphor derivatives exhibits high sun-protection at low concentration, and produces both thermally and photochemically stable composition without toxicity.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are unpersuasive.

Applicants assert that the § 102 rejection over Boussouira is improper allegedly because the reference fails to teach the claimed combination of retinol and the camphorsulphonic acid derivative. Applicants assert that the reference merely provide

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a “general disclosure relating to the theoretical combination of potentially thousands of vitamin A derivatives with thousands of sunscreen agents”. Examiner respectfully notes that the reference in fact specifically teaches to add at oneast on sunscreen “to reinforce the stability of the combination of the retinoid with the polyamino polymer, by limiting the harmful action of UV on the retinoid”. While Boussouira enlists several example sunscreensing agents, the reference particularly mentions the claimed sunscreensing active as a hydrophilic screensing agent. Examiner maintains the rejection since it is anticipated that a skilled worker in cosmetic art would make claimed composition and use the composition as taught by the reference.

While applicants argue that the reference fails to expressly teach the claimed stabilizing effect of the sunscreensing agent on retinol, examiner respectfully notes that the stability of the retinol/sunscreensing composition is a resulting physical property of the combination as taught by the reference.

Applicants’ statement that the Boussouira teaches that the sunscreens “reinforce the stability of the retinoid/histidine combination” is incorrect. The reference in fact teaches that the stability is achieved by “limiting the harmful action of UV on the retinoid”. See col. 7, lines 52 – 57.

While applicants argue that the cited references Boussouira neither teaches or suggests that certain UVA sunscreens decompose retinol, examiner finds the argument unpersuasive. The claimed invention is a composition, and Boussouira discloses that combining a retinoid with certain sunscreensing agents as claimed in the instant case is notoriously well known in the art.

Applicants make analogous arguments for the § 103 rejection, asserting that neither Harding or Forestier teaches that certain UVA sunscreens decompose retinol. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the motivation to use the camphorsulfonic acid suncreening agent is found in the specific teaching in Forestier that the camphor derivatives exhibits high sun-protection at low concentration, and produces both thermally and photochemically stable composition without toxicity. Examiner takes the position that obtaining the advantage of the camphorsulfonic acid derivative over Parsol 1789 (i.e., stabilizing retinol) would naturally flow from composition made as motivated by the collective teachings of the references.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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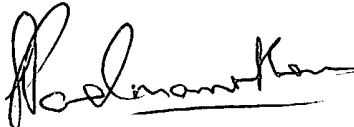
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER